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Yoshio Sasaki

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SAUNDERS JR, JOSEPH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 11, 2009 have been fully considered but they are not persuasive. Applicant begins by stating, "Applicants respectfully traverse the rejection of claims 1, 3, 6-10, 12-14, 16, 17, 19, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Mercer, Han, and Hartley. No prima facie case of obviousness has been established. Independent claim 1 recites an audio playback apparatus including "means for specifying a shuffle range," and "means for randomly selecting a next music file group from within the shuffle range, wherein the next music file group comprises at least two music files."," beginning on page 10 of the remarks.

2. However, Applicant then incorrectly states, "On page 4 of the Final Office Action, the Examiner concedes that Mercer does not teach or suggest the claimed "means for randomly selecting." Moreover, Han also does not teach or suggest the claimed "means for randomly selecting." On page 4 of the Final Office Action, the Examiner **does not concede** that Mercer does not teach or suggest the claimed "means for randomly selecting." the Examiner stated, "Further, while Mercer teaches a means for specifying a shuffle unit; Mercer does not disclose means for specifying a shuffle range, and therefore does not teach the next music file group is selected from within the shuffle range". The Examiner explicitly showed that Mercer teaches "means for randomly selecting" on page 3 of the Final Office Action, where it states, "The user also can manipulate the created playlists by shuffling the playlists. Such shuffle or random play options may operate at the group level or at the individual media file level, which allows,

Art Unit: 2614

for example, playback of all songs by a random artist before proceeding to the next random artist," Mercer Column 4 Line 29 – Column 6 Line 59. The Examiner then relied on Hartley to disclose the "means for specifying a shuffle range". As stated in the Final Office Action on page 4, "Hartley teaches, "Many players afford the users the ability to play music in random order. However, a combination of random selection and some sort of preference would be useful," [0021]. Hartley goes on and teaches that such a preference can be implemented through the use of a range of values for a parameter, a parameter including any property of the file that is tracked by the player [0023], "the player would then perform the shuffle on only those files having a value for a particular user-defined parameter, allowing the user to eliminate files that do not fit a particular category," [0031]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a shuffle range as taught by Hartley in addition to the shuffle unit as taught by Mercer, thereby allowing for a sort preference to be included in the invention of Mercer and Han having the advantage of "allowing the user to eliminate files that do not fit a particular category," Hartley [0031].

3. In other words, the shuffle unit of Mercer has "means for randomly selecting" but not for "means for specifying a shuffle range" and therefore since "Hartley teaches, "Many players afford the users the ability to play music in random order. However, a combination of random selection and some sort of preference would be useful," [0021]," as stated in the Final Office Action, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a shuffle range as taught by Hartley "thereby allowing for a sort preference to be included in the invention of Mercer and Han

Art Unit: 2614

having the advantage of "allowing the user to eliminate files that do not fit a particular category," Hartley [0031]," also stated in the Final Office Action. Therefore, since as agreed by Applicant, "Hartley discloses shuffling among songs in a user-defined category. Hartley, ¶ [0031].," and there is proper motivation provided by Hartley [0021] to include some sort of preference or range in combination with random selection, the combination is deemed proper.

4. Applicant is reminded that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, while "Hartley does not teach or suggest "means for randomly selecting a next music file group from within the shuffle range, wherein the next music file group comprises at least two music files," as recited in claim 1 (emphasis added)," the combination of Mercer, Han, and Hartley do teach all of the claimed limitations as addressed above including the newly amended limitation of "wherein the next music file group comprises at least two music files". With regard to the newly amended limitation the Examiner agrees with the Applicant's statement on page 12 of the remarks that the "proposed amendments do not raise new issues or necessitate the undertaking of any additional search or art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined," emphasis added by Examiner, since a group is defined as "two or more figures forming a complete unit in a composition" by Merriam-Webster,

Art Unit: 2614

<http://www.merriam-webster.com/dictionary/group>. Therefore, the limitation of “wherein the next music file group comprises at least two music files”, is met by Mercer since Mercer teaches the claimed group as illustrated in Figure 3 e.g., GROUP 3, and disclosed as “a group of audio files,” Column 5 Line 25. Therefore, the combination of Mercer, Han, and Hartley teach all of the subject matter of claim 1 and likewise the other independent claims. The rejection of claims 1, 3, 6 – 10, 12 – 14 and 16 – 23 is maintained in view of the reasons presented above in regards to the newly amended limitations and previously presented limitations as presented in the Final Office Action dated January 21, 2009.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

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/J. S./

Examiner, Art Unit 2614

/CURTIS KUNTZ/

Supervisory Patent Examiner, Art Unit 2614